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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/652,115	08/30/2003	James J. O'Connor	0020-3 CIP	1836
25901	7590	01/13/2006	EXAMINER	
ERNEST D. BUFF ERNEST D. BUFF AND ASSOCIATES, LLC. 231 SOMERVILLE ROAD BEDMINSTER, NJ 07921			JAGAN, MIRELLYS	
			ART UNIT	PAPER NUMBER
			2859	

DATE MAILED: 01/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/652,115

Applicant(s)

O'CONNOR, JAMES J.

Examiner

Mirellys Jagan

Art Unit

2859

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2 and 5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Objections*

1. Claims 1, 2, and 5 are objected to because of the following informalities:

In claim 1, it is not clear if the selected standard or code claimed in lines 9 and 17 is referring to the standard or code claimed in line 6.

Claims 2 and 5 are objected for being dependent on an objected base claim. Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 2, and 5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The original disclosure states that the length is 6 feet, or about 6 feet, for spacing the boxes horizontally from one another, but fails to describe the apparatus as having a length of between 4 feet to about 6 feet, as claimed in claim 1. Claims 2 and 5 are rejected for being dependent on a rejected base claim.

*Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,072,523 to Bennett in view of U.S. Patent 5,222,303 to Jardine and U.S. Patent 5,598,638 to Plesh.

Bennett discloses an apparatus comprising:

an elongated body with first and second ends and front and back sides;

a plurality of slots disposed on the body at a plurality of locations, each slot determining placement of electrical boxes and located at a location on the body that conforms to a proper height for placement of the boxes, i.e., codes and standards, such that a single electrical box may be located at different heights that are inherently unrelated;

whereby said measuring apparatus positions said electrical boxes in level at precise locations above a floor in compliance with applicable standards and codes.

Bennett does not disclose the apparatus having length of 4-6 feet; a width of 2-4 inches; a set of indicia located along each edge of the front side of the body for indicating the distance of the slots from the first end; and a level for vertically leveling the apparatus.

Jardine discloses a measuring apparatus for locating the position of an electrical box. The apparatus has a level (26) thereon for properly positioning the apparatus vertically to allow

Art Unit: 2859

accurate positioning of the box, and indicia along an edge of the front side of the body for indicating distance from a first end.

Plesh discloses an apparatus for marking the location of electrical boxes on a wall. The apparatus has an elongated body for determining placement of a box above a floor in accordance with desired standards such that a single box may be located at different heights that are unrelated to each other. The length of the body is between 4 to about 6 feet and the width of a first end of the body is 2-4 inches in order to place a box vertically along the length of a wall or stud (see figure 1; and column 4, lines 55-60).

Referring to claim 1, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus disclosed by Bennett by adding a level to the apparatus and indicia along a front edge of the body, as taught by Jardine, in order to properly position the apparatus vertically when positioning an electrical box, and in order to visually determine the height of a particular slot to position a box in a desired and proper location from the floor.

Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus of Bennett by making the body having a length between 4 to about 6 feet and a width of a first end of 2-4 inches, as taught by Plesh, in order to place a box vertically along the length of a wall or stud.

Lastly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus of Bennett, Jardine, and Plesh by providing indicia on both edges of the body in order to determine the distance of all of the slots from the floor, and since it has been held that the mere duplication of the essential working parts of a device involves only routine skill in the art. See *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Art Unit: 2859

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett, Jardine, and Plesh, as applied to claims 1 and 5 above, and further in view of U.S. Patent 2,713,203 to Gottlieb.

Bennett, Jardine, and Plesh disclose an apparatus having all of the limitations of claim 2, as stated above in paragraph 5, except for the apparatus having a textual portion of a code or standard.

Gottlieb discloses a measuring apparatus for marking and locating the position a line conforming to building laws and other requirements [i.e., codes and standards] for marking a straight line. The apparatus may have text for indicating instructions and guidelines to allow an inexperienced individual using the apparatus to conform to building laws and other requirements [i.e., codes and standards](see column 3, line 68-column 4, line 10).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus disclosed by Bennett, Jardine, and Plesh by adding a textual portion of the standard or codes on the apparatus since Gottlieb teaches that providing a text of building laws or other requirements is beneficial since it allows an inexperienced individual using the apparatus to conform to building laws and other requirements.

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1, 2, and 5 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mirellys Jagan whose telephone number is 571-272-2247. The examiner can normally be reached on Monday-Friday from 11AM to 4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez can be reached on 571-272-2245. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJ  
January 9, 2006



**Diego Gutierrez  
Supervisory Patent Examiner  
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